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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,872	01/24/2002	Samuel Kallner	KALLNER1	5341

1444 7590 03/23/2007
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EXAMINER

AILES, BENJAMIN A

ART UNIT	PAPER NUMBER
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2142

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/053,872	Applicant(s) KALLNER ET AL.	
	Examiner Benjamin A. Ailes	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-16,26,29-41,56 and 59-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-16,26,29-41,56 and 59-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to correspondence filed 06 February 2007.
2. Claims 1, 4-16, 26, 29-41, 56, and 59-71 remain pending.

Response to Declaration

3. The Declaration filed on 06 February 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Klein (US 6,999,448 B1) reference.
4. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Klein reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In the filed Declaration the applicants have shown conception of the present invention on or before March 13, 2000 using Exhibit A titled "Network Infrastructure Design" and have also including claim mapping clearly showing how Exhibit A discloses each and every element of claim 1. By showing conception of filed claim 1, applicants' have also shown conception of the corresponding independent claims, claims 26 and 56. While the applicants have shown conception of filed claims 1, 26 and 56, the applicants have not shown conception of all dependent claims, namely 4-16, 29-41 and 59-71. It is unnecessary for the applicants to demonstrate conception for all of the dependent claims, namely 4-16, 29-41 and 59-71, if the dependent claims are obvious variations.

Art Unit: 2142

5. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Klein reference to either a constructive reduction to practice or an actual reduction to practice. As proof of diligence, applicants submitted Exhibit B, a version control listing for the HRL JTAPI project, and state that the listing shows that updates were performed regularly during the period between March 14 and June 21, 2000. Applicants have not established facts between March 14 and June 21, 2000 because they have failed to show specifically within Exhibit B, the change log, as to when the relevant classes were actually updated and how they relate to the previously filed source code which was submitted previously on 28 April 2006, Annex A. Therefore, the evidentiary burden has not been met.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2142

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 4-13, 15, 16, 26, 29-38, 40, 41, 56, 59-68, 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smyk (U.S. 6,597,686) in view of Gaus et al. (U.S. 6,778,652 B2), hereinafter referred to as Gaus and further in view of Klein (U.S. 6,999,448 B1).

9. Regarding claims 1, 26, and 56, Smyk teaches the method for communication, comprising:

receiving a request from a first party, submitted via a first communication service provider to a telephony application, to place a call using the application to a second party (col. 6, lines 26-32, Smyk teaches a first caller (first party) dialing a telephone number to connect to a second user (second party));

responsive to a characteristic of the call placed by the first party, selecting a second communication service provider to carry the call between the application and the second party (col. 6, lines 30-34, Smyk teaches the method wherein the service control point (SCP) determines how the call should be routed based on a call processing record (a second communication service provider) for example via standard telephone network (STN) or via the Internet); and

connecting the second party via the second communication service provider to communicate with the first party using the application (col. 6, lines 43-46, Smyk teaches the first and second caller (party) being connected for communication).

Smyk teaches the first and second parties being connected via a SCP (gateway) and the ability to determine dynamically whether the call is being made through STN or the Internet (see col. 6, lines 23-38), but does not explicitly teach steps being performed behind the scenes as the request comprising the steps of submitting the request to the application via an Application Programming Interface (API), which exposes a platform-independent call model to the application, and wherein connecting the second party comprises connecting the call responsive to an instruction submitted by the application to the API. However, Gaus teaches the use of an API to provide services which are determined to be needed based on characteristics provided and provides services such as the ones needed, specifically the service of connection establishment as part of an interface system that serves to integrate PSTN and Internet telephony (see Gaus, col. 15, lines 53-65). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the use of an API to assist in connection establishment when services are needed to be determined dynamically, for example in the connection establishment methods as taught by Smyk. One of ordinary skill in the art would have been motivated to make such a combination for the reason stated above, this reason being the ability to provide services dynamically based on service characteristics (see Gaus, col. 15, lines 53-59).

Smyk teaches the first and second parties being connected via a SCP (gateway) and the ability to determine dynamically whether the call is being made through STN or the Internet (see col. 6, lines 23-38), but does not explicitly teach steps being performed behind the scenes which in combination with Gaus provides the general use of an API.

Art Unit: 2142

The combination of Smyk and Gaus does not explicitly show the arrangements of the service providers having respective signaling stacks and the call model being independent of these signaling stacks. Gaus teaches the use of an abstract service layer which provides the abstract call model which is able to dynamically provide the needed call model for calls being made from the first party to the second party. The implementation of the telephony signaling stacks being independent from the call model is deemed an implicit feature as taught by Klein. Klein teaches a communication network wherein a first party and a second party establish a connection, similar to the connection made as taught by Smyk. The connection made by Klein includes the use of each caller having a separate signaling and protocol stack (see figure 1 and col. 3, ll. 31-35 wherein multiple PC like phones can be connected; col. 5, ll. 2-12) and the application (interface software by which the connection is made) being independent of the respective signaling and protocol stacks. Klein teaches the use of a system wherein multiple communication protocols may be used and establish connections with each other, for example internet telephony and PSTN. The multiple communication protocol system allows any number of protocol based networks, protocol stacks and signaling adapters to be used in order for the establishment of connections to be made possible (see Klein, Figure 1). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to implement the methods for multiple communication protocol as disclosed by Klein, specifically the ability for the first party and the second party to have independent telephony signaling stacks, as well as being independent from the connection medium (the application), in combination with the

connection establishment methods and the use of an API as mentioned above and as taught by Smyk and Gaus. One of ordinary skill in the art would have been motivated to make the above combination in order to provide a system wherein a multitude of protocols used by different users (parties) can communicate with each other effortlessly and efficiently (see Klein, col. 1, lines 58-67).

10. Regarding claims 4, 29, and 59, in view of the combination set forth above, Klein teaches the method for passing messages from the first stack through the application to the second stack (see Klien, fig. 1 and col. 5, ll. 4-12). Figure 1 and col. 3, ll. 31-35 also teaches the stacks being independent from each other and the application interface as mentioned above in the rejection of claim 1. The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 4, 29, and 59 as used above in the rejections of claims 1, 26, and 56.

11. Regarding claims 5, 30, and 60, in view of the combination set forth above, Gaus teaches the use of providing modules to first and second signaling stacks to assist in connection establishment (see Gaus, col. 15, lines 56-58). The modules used are deemed functionally equivalent in the art to the claimed "plug-in programs" as disclosed by the applicant. The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 5, 30, and 60 as used above in the rejections of claims 1, 26, and 56.

12. Regarding claims 6, 31, and 61, in view of the combination set forth above, Gaus teaches the use of providing modules to first and second signaling stacks to assist in connection establishment (see Gaus, col. 15, lines 56-58). The modules used are

Art Unit: 2142

deemed functionally equivalent in the art to the claimed "plug-in programs" as disclosed by the applicant. The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 6, 31, and 61 as used above in the rejections of claims 1, 26, and 56.

13. Regarding claims 7, 32, and 62, in view of the combination set forth above, Gaus teaches the use of a service layer (a service abstraction layer (SAL)) which is used to determine what services, modules, software services, and tools will be needed to assist in connection establishment steps. This is deemed functionally equivalent to applicant's claimed step of "selecting the second plug-in program comprising passing information regarding the call to a service manager program via a service management interface of the abstract call model, wherein the service manager program processes the information to determine the characteristic, and selects the second plug-in program responsive to the characteristic from a registry of the plug-in programs." The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 7, 32, and 62 as used above in the rejections of claims 1, 26, and 56.

14. Regarding claims 8, 33, and 63, Smyk teaches that receiving the request comprises receiving an address of the second party to whom the call is to be placed (col. 6, lines 26-27), and wherein selecting the second communication service provider comprises parsing the address to determine the second communication service provider that should be selected (col. 5, line 67 – col. 6, line 3). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 8, 33, and 63 as used above in the rejections of claims 1, 26, and 56.

Art Unit: 2142

15. Regarding claims 9, 34, and 64, Smyk teaches receiving the address comprising receiving a telephone number (col. 6, lines 26-27), and wherein parsing the address comprises identifying the second communication provider based on a portion of the telephone number (col. 6, lines 7-11). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 9, 34, and 64 as used above in the rejections of claims 1, 26, and 56.

16. Regarding claims 10, 35, and 65, Smyk teaches selecting the second communication service provider comprising determining a communication protocol to be used in communicating with the second party, and choosing the second communication service provider such that the second communication service provide supports the communication protocol (col. 6, lines 32-34; col. 3, lines 33-35). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 10, 35, and 65 as used above in the rejections of claims 1, 26, and 56.

17. Regarding claims 11, 36, and 66, Smyk teaches receiving the request from the first party comprising communicating with the first party via the first communication service provider using a first communication protocol (col. 6, lines 26-28; col. 3, lines 33-34), and wherein the communication protocol used in communicating with the second party comprises a second communication protocol, different from the first protocol (col. 6, lines 43-46; col. 3, lines 34-35). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 11, 36, and 66 as used above in the rejections of claims 1, 26, and 56.

18. Regarding claims 12, 37, and 67, Smyk teaches that one of the first and second communication protocols comprises a circuit-switched network protocol, while the other of the first and second communication protocols comprises a packet-switched network protocol (col. 3, lines 33-35). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 12, 37, and 67 as used above in the rejections of claims 1, 26, and 56.

19. Regarding claims 13, 38, and 68, Smyk teaches selecting the second communication service provider comprising specifying a selection rule, and applying the selection rule to the characteristic in order to determine the second communication service provider to be selected (col. 5, lines 50-55; col. 5, line 67 – col. 6, line 3). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 13, 38, and 68 as used above in the rejections of claims 1, 26, and 56.

20. Regarding claims 15, 40, and 70, Smyk teaches the telephony application comprising a teleconferencing application, and wherein connecting the second party comprises establishing a teleconference between the first and second parties (col. 6, lines 30-32; col. 6, lines 43-46). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 15, 40, and 70 as used above in the rejections of claims 1, 26, and 56.

21. Regarding claims 16, 41, and 71, Smyk teaches the telephony application comprising a call center application, and wherein connecting the second party comprising establishing voice communications between a customer and a call center

Art Unit: 2142

agent (col. 6, lines 30-32; col. 6, lines 43-46). The motivation to combine the references of Smyk, Gaus, and Klein applies for the same reasons for claims 16, 41, and 71 as used above in the rejections of claims 1, 26, and 56.

22. Claims 14, 39, and 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smyk, Gaus, and Klein in view of Hetz (U.S. 6,185,289).

23. Regarding claims 14, 39, and 69, Smyk, Gaus, and Klein do not explicitly disclose that specifying the selection rule comprises specifying a temporal criterion, so that the second communication service provider is selected depending on a point in time at which the call is placed. However, Hetz teaches that a subscriber may specify a profile that states that a particular service provider should be used if a call is placed during a particular time interval (col. 7, lines 52-56). One of ordinary skill in the art at the time the invention was made would have found it obvious to allow Smyk's preference information to specify time criteria for which service providers should be selected, as taught by Hetz. One of ordinary skill in the art would have been motivated to make such a combination in to allow the customer to specify times during which a particular service provider should be used because of the service provider's rate structure (see Smyk, col. 3, lines 2-5).

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 6:30-4, IFP Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2142

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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